Docket No. 2308.03 **TRADEMARKS**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: **The Last Outlaws, Inc.**
SERIAL NO.: **85/127202**
MARK: **OUTLAWS**
FILED: **September 10, 2010**

Trademark Attorney:
Sara N. Benjamin
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RESPONSE A

In response to the outstanding Office Action mailed December 22, 2010, having a period for response set to expire June 22, 2011, Applicant responds to the Office Action for the above-identified trademark application a first time as follows:

Amendment to Goods and Services:

Applicant wishes to amend the recitation of goods and services, for which registration of the mark OUTLAWS is being sought, to state the following:

Entertainment, namely, live musical performances in the country rock genre

Refusal: Section 2(d)-Likelihood of Confusion

Applicant's mark stands rejected under the Trademark Act Section 2(d) (15 U.S.C. §1052(d)), because the Applicant's mark OUTLAWS allegedly so resembles U.S. Registration 2,889,457 for OUTLAWZ and U.S. Registration 2,847,749 for OUTLAW RECORDS that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of Applicant and Registrant. Applicant respectfully traverses the rejection and presents the following remarks in support.

It is well-established that an applicant's trademark shall not be refused registration unless it consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause

mistake, or to deceive.[1] Applicant respectfully traverses the rejection on the following grounds: (1) the mark OUTLAW RECORDS has been cancelled as of January 7, 2011; and (2) there is no likelihood of confusion between the Applicant's mark OUTLAWS and the Registrant's mark OUTLAWZ because the respective goods and services, as currently amended, lie in the polar opposite genres of music.

The Respective Goods and Services are Dissimilar

The goods identified in the application and those goods and services described by the Registrant are "similar" to the extent that the goods exist within the general realm, or field, of live music performances. However, mere similarity in field of application or endeavor is not the test.

Where *ex parte* examinations or *inter partes* proceedings are involved, the PTO is to use the modern "related goods" test to determine the likelihood of confusion.[2] A likelihood of confusion under the modern rule is determined by whether consumers would erroneously presume that the goods offered by the applicant originate or are somehow associated, either through sponsorship or origination, with that of the registered mark.[3] The type of goods and services offered, as well as, the sophistication of the consumers make consumer confusion unlikely.

While the respective goods and services may fall under the same general product category of prerecorded music and live musical performances, they operate in distinct niches. The respective goods and services belong to distinct sectors of a broad product category, they are sufficiently unrelated, and consumers are not likely to assume the products originate from the same mark.[4]

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[1] Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 717, 21 U.S.P.Q.2d 1388 (C.A. Fed. 1992)

[2] McCarthy on Trademarks §23:78 Lanham Act 2(d) – the Modern Test is Used; *citing* Luzier, Inc. v. Marlyn Chemical Co., 442 F.2d 973, 169 U.S.P.Q. 797 (C.C.P.A. 1971); Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d 1335, 209 U.S.P.Q. 986 (C.C.P.A. 1981).

[3] Id. §24:63 Refusal of federal registration under Lanham Act §2(d) - related goods test is applied; *citing* Tiffany & Co. v. Tiffany Tile Corp., 52 C.C.P.A. 1396, 345 F.2d 214, 145 U.S.P.Q. 483 (1965); In re Arthur Holland, Inc., 192 U.S.P.Q. 494, 1976 WL 21149 (T.T.A.B. 1976); The Corporation of Lloyd's v. Louis D'or of France, Inc., 202 U.S.P.Q. 313, 1979 WL 24839 (T.T.A.B. 1979); Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d 1335, 209 U.S.P.Q. 986 (C.C.P.A. 1981); The All England Lawn Tennis Club (Wimbledon) Limited v. Creations Aromatiques, Inc., 220 U.S.P.Q. 1069, 1983 WL 51903 (T.T.A.B. 1983); In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 U.S.P.Q. 1289 (Fed. Cir. 1984); In re Save Venice New York, Inc., 259 F.3d 1346, 59 U.S.P.Q.2d 1778 (Fed. Cir. 2001).

[4] *See, e.g.,* Commerce Nat. Ins. Services, Inc. v. Commerce Ins. Agency, Inc., 214 F.3d 432, 441 (3rd Cir. 2000) (holding marks held by company operating in banking industry and company operating in insurance industry did not create consumer confusion because the two companies were involved in distinct highly regulated industries); Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1207 (1st Cir., 1983) (finding no product similarity in medical technology sold to different departments in hospital because " 'the hospital community' is not a homogeneous whole, but is composed of separate departments with diverse purchasing requirements, which, in effect, constitute different markets for the parties' respective products."); Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc., 952 F.Supp. 1084, 1095 (D.N.J., 1997) (finding no product similarity between professional competitive basketball team and "show basketball" team)

The musical genre of country rock, in which the Applicant wishes to provide live music entertainment services, is on the polar opposite end of the musical spectrum from the genres of rap and hip-hop, in which Registrant provides its goods and services. The consumer market for live music performances in the genre of country rock does not overlap with the consumer market for goods and services associated with rap and hip-hop. As the data available on Amazon.com (one of the largest sellers of prerecorded music in the United States) clearly shows, consumers who purchase music records in the genre of country rock almost never purchase music records in the genres of hip-hop, and vise versa. This is strong evidence in support of Applicant's contention that consumers, who purchase tickets for live music performances, will not be confused, mistaken, or deceived that live musical performances associated with the Applicant's mark OUTLAWS in the genre of country rock originate from the same source as the goods and services sold under the Registrant's mark OUTLAWZ.

Furthermore, purchasing a concert ticket is an act that involves a fair amount of though and deliberation on the part of consumer. Therefore, it is unlikely that a consumer will mistakenly purchase a concert ticket to a live country rock music performance if she wishes to attend a hip-hop concert.

Conclusion

Because the goods and services are distinct, no likelihood of confusion exists as to the source of Applicant's goods. Therefore, Applicant respectfully requests withdraw of the rejection on these grounds.

Having complied with all outstanding issues, Applicant respectfully requests a Notice of Publication. If Office cannot publish the mark for opposition at this time for any reason, or if an amendment by Office would place the mark in condition for publication, a telephone call to the undersigned at (813) 925-8505 is requested.

Very respectfully,

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By:_____

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